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To: Commissioner for Patents
Examiner Chang, Shirley

Firm: U.S. Patent and Trademark Office
Art Unit 2612

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From: Thomas F. Presson

Date: September 28, 2006

Re: FLH Ref No.: 450100-03386
Serial No: 09/920,883

Number of Pages: 19
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00317695

U.S. Application. No. 09/920,883
Appellant's Brief

PATENT
450100-03386

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Shin Iima, et al.
Serial No. : 09/920,883
For : COMMUNICATION APPARATUS,
COMMUNICATION SYSTEM, AND METHOD
OF SAME
Filed : August 02, 2001
Examiner : Chang, Shirley
Art Unit : 2612
Confirmation No. : 5191

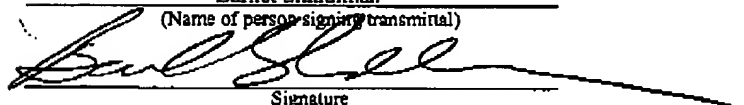
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(Name of person signing transmittal)



Signature

September 28, 2006
Date of Signature

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed on August 30,
2006, having a one-month statutory period for response set to expire on September 30, 2006,
Appellants submit herewith a complete listing of the claims and revised remarks.

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1. **REAL PARTY IN INTEREST**

The real party in interest is Sony Corporation, a Japanese Corporation with offices at 7-35 Kitashinagawa 6-chome, Shinagawa-ku, Tokyo, 141-0001 Japan. The assignment of this application is recorded in the United States Patent and Trademark office at Reel 012049; Frame 0783.

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2. **RELATED APPEALS AND INTERFERENCES**

Upon information and belief, the undersigned attorney does not believe that there is any appeal or interference that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. **STATUS OF THE CLAIMS**

The Application was filed with claims 1-14 on August 2, 2001, and assigned Application Serial No. 09/920,883. This application claims the benefit of Japanese Patent Application No. 2000-235220, filed on August 3, 2000.

The Examiner issued an Office Action on July 15, 2005. In the Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,698,020 to Zigmond, et al. (hereinafter, merely "Zigmond").

In response to the Office Action Appellant submitted a response amendment on October 14, 2005 arguing the patentably distinct features of the application over the cited reference.

The Examiner then issued a Final Office Action on December 29, 2005. In the Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. §103(a) as allegedly unpatentable over Zigmond in view of U.S. Pub. No. 2002/0010927 A1 to Kim (hereinafter, merely "Kim").

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A response to the Final Office Action was filed by Appellant on March 29, 2006 traversing the Examiner's rejections of the claims.

The Examiner issued an Advisory Action on April 7, 2006, maintaining the rejections recited in the Final Office Action.

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A Notice of Appeal was filed by Appellant with a Pre-Appeal Brief Request for Review on April 21, 2006, from which this Appeal Brief is being filed.

A Notice of Panel Decision was mailed on June 6, 2006 indicating claims 1-14 were rejected.

Accordingly, the status of the claims may be summarized as follows:

| | |
|------------------|-------|
| Claims Allowed: | None. |
| Claims Rejected: | 1-14. |
| Claims Appealed: | 1-14. |

The rejected claims 1-14 are set forth in the Appendix attached hereto.

Appellants appeal the Final Rejection of claims 1-14, which constitute all of the currently pending claims in this application.

4. STATUS OF THE AMENDMENTS

Appellants believe that all the submitted Amendments have been entered.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

The citations to Figures and Specification locations are provided immediately following elements of independent claim 1, which is summarized below. However, such citations are provided merely as examples and are not intended to limit the interpretation of the claims or to evidence or create any estoppel.

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There are four independent claims (1, 4, 10 and 11) in the instant application at issue in this appeal, and are directed to a communication apparatus. The broadcast apparatus 60 generates a broadcast signal S60 comprised of a mix of a program signal PS and an additional signal AS and broadcasts the related broadcast signal S60 to the user side receiving apparatus 70 by a wired or wireless method. The broadcast apparatus 60 receives the log information from the user side transmitter 80 and charges the related user based on the related log information. The receiver 71 receives the broadcast signal S60 transmitted by the broadcast apparatus 60, performs a processing such as demodulation, decoding, and error correction according to need, and then outputs the related broadcast signal to the filter 72. The filter 72 separates the program signal PS and the additional signal AS mixed in the broadcast signal input from the receiver 71, writes the separated program signal PS in the program signal use memory 73, and writes the separated additional signal AS in the additional signal use memory 74. The display 76 displays, in addition to the image corresponding to the program signal PS, an image corresponding to the additional signal AS according to need in accordance with a display instruction of the user using the operation unit 82. In this case, the image corresponding to the additional signal AS may be displayed simultaneously with the image corresponding to the program signal PS (inside the same window or outside the window of the program) or may be displayed in the middle of the program.

Claim 1 is directed to a communication apparatus comprising (Page 11, lines 2-5; Figure 1, 70): a receiving means for receiving a signal comprised of a program signal and an additional signal (Page 11, lines 17-21; Figure 1, 71); a separating means for separating the program signal and the additional signal from said received signal (Page 11, line 22-Page 12, line 2; Figure 1, 72); a determining means for determining whether to output in accordance with said additional signal (Page 13, line 22-Page 14, line 1; Figure 1, 82); an output signal generating means for

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generating an output signal by using said separated program signal and additional signal upon determination to output in accordance with said additional signal and for generating the output signal by using said separated program signal where it is determined not to output in accordance with said additional signal (Page 12, lines 20-25; Figure 1, 77); and an outputting means for outputting information in accordance with said generated output signal (Page 12, lines 8-14; Figure 1, 76); wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal (Page 12, lines 15-19); and wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service (Page 10, lines 10-25).

Claim 4 is directed to a communication system comprising (Page 9, lines 4-7; Figure 1, 61): a first communication apparatus for transmitting a signal comprised of a program signal and an additional signal (Page 9, line 23-Page 10, line 2; Figure 1, 60); and a second communication apparatus for receiving a signal transmitted by said first communication apparatus, said second communication apparatus comprising (Page 11, lines 2-5; Figure 1, 70): a receiving means for receiving the signal transmitted by said first communication apparatus (Page 11, lines 17-21; Figure 1, 71); a separating means for separating the program signal and the additional signal from said received signal (Page 11, line 22-Page 12, line 2; Figure 1, 72); a determining means for deciding whether to output in accordance with said additional signal (Page 13, line 22-Page 14, line 1; Figure 1, 82); an output signal generating means for generating an output signal by using said separated program signal and said additional signal when it is decided to output in accordance with said additional signal and generating an output signal by using said separated program signal where it is decided not to output in accordance with said additional signal (Page 12, lines 20-25; Figure 1, 77); and an outputting means for outputting information in accordance

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with said generated output signal (Page 12, lines 8-14; Figure 1, 76); wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal (Page 12, lines 15-19); and wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service (Page 10, lines 10-25).

Claim 10 is directed to a communication apparatus comprising (Page 11, lines 2-5; Figure 1, 70): an operating means operated by a user (Page 13, line 22-Page 14, line 1; Figure 1, 82); a transmitting means for issuing a request instructing the transmission of an additional signal in accordance with operation of said operating means by said user (Page 13, lines 6-11; Figure 1, 80); a receiving means for receiving a signal comprised of a program signal and an additional signal in accordance with said request (Page 11, lines 17-21; Figure 1, 71); a separating means for separating the program signal and the additional signal from said received signal (Page 11, line 22-Page 12, line 2; Figure 1, 72); an output signal generating means for generating an output signal by using said separated program signal and additional signal (Page 12, lines 20-25; Figure 1, 77); and an outputting means for output information in accordance with said generated output signal (Page 12, lines 8-14; Figure 1, 76); wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal (Page 12, lines 15-19); and wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service (Page 10, lines 10-25).

Claim 11 is directed to a communication method of a reception side of a signal comprised of a program signal and an additional signal, comprising the steps of (Page 14, lines 7-16):

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separating a program signal and an additional signal from said received signal (Page 14, lines 18-20; Figure 2, ST3); determining whether to output in accordance with said additional signal (Page 15, lines 2-6; Figure 3, ST5); generating an output signal by using said separated program signal and additional signal where it is decided to output in accordance with said additional signal (Page 15, lines 8-16; Figure 3, ST6); generating an output signal by using said separated program signal when it is decided not to output in accordance with said additional signal (Page 15, lines 18-24; Figure 3, ST7); outputting information in accordance with said generated output signal (Page 15, lines 8-24); displaying the additional signal simultaneously with the program signal inside or outside a window of a program corresponding to the program signal (Page 12, lines 15-19); reducing a viewing fee by a predetermined amount when the displayed additional signal is an advertisement (Page 10, lines 10-19); and increasing the viewing fee by a predetermined amount when the displayed additional signal is an additional service (Page 10, lines 20-25).

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Applicants request a pre-appeal brief conference to review the rejection of:

- 1) Claims 1-14 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,698,020 to Zigmond, et al. (hereinafter, merely "Zigmond") in view of U.S. Pub. No. 2002/0010927 to Kim (hereinafter, merely "Kim");

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7. ARGUMENTS

The §103 Rejections Should be Withdrawn Because Claim Features are Not Disclosed, Taught or Suggested in the Reference

Appellants' arguments in support of patentability of independent claims 1, 4, 10 and 11 are found in the reply filed March 29, 2006 at page 10. In summary, the present application claims a communication apparatus, wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal. (*emphasis added*)

In the December 29, 2005 Final Office Action, it was argued that Zigmond in view of Kim renders obvious the underlined limitation. *See Final Office Action, page 6.* However, Kim was filed on January 12, 2001, and claims priority to U.S. Provisional Application 60/176,121 filed on January 14, 2000. The present application has a priority date of August 3, 2000. Thus, Appellants are entitled to an effective filing date of August 3, 2000, which is prior to Kim's filing date of January 12, 2001.

Upon review of U.S. Provisional Application 60/176,121, Appellants submit that there is no disclosure that would support the rejection. The portion of Kim relied upon by the Final Office Action, paragraph [0076], is not part of U.S. Provisional Application 60/176,121.

The April 7, 2006 Advisory Action argued that the underlined limitation is taught on page one, the first paragraph on page three, the first paragraph on page four and figure 2 of U.S. Provisional Application 60/176,121. Page one merely discloses "that the SO can occupy partially the user's video presentation device connected to the Free Digital TV receiver to present Banner Information for commercial advertisement purpose". The first paragraph on page 3 merely discloses "that the Digital TV Service Operator (SO) can present commercial banner advertisement on their video presentation devices." The first paragraph on page 4 merely

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discloses "the user's Free Digital TV receiver receives and demodulates the signal of the channel that the user tuned, decodes and delivers the regular TV programs to the user's presentation device, and also decodes, renders, and presents the Banner Information to the user's video presentation device." The cited portions of the provisional application do not teach or suggest that the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal.

Therefore, Zigmond and Kim, individually or in combination, fail to teach or suggest a communication apparatus, wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal. Therefore, Zigmond in view of Kim fails to teach or suggest all the limitations recited in claim 1.

Based on the foregoing discussion, it is submitted that claim 1 should be allowable over Zigmond and Kim. Since independent claims 4, 10 and 11 closely parallel claim 1, claims 4, 10 and 11 should be allowable over Zigmond and Kim.

Since claims 2 and 3 depend from independent claim 1, claims 2 and 3 should be allowable over Zigmond and Kim. Since claims 5-9 depend from independent claims 4, claims 5-9 should be allowable over Zigmond and Kim. Since claims 12-14 depend from independent claim 11, claims 12-14 should be allowable over Zigmond and Kim.

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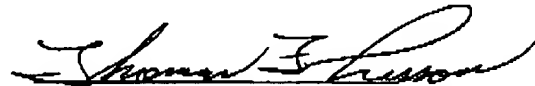
CONCLUSION

For the reasons discussed above, claims 1-14 are patentable. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 1-14, and a reversal by the Board is solicited.

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APPENDIX I
CLAIMS ON APPEAL

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1. (Previously Presented) A communication apparatus comprising:
a receiving means for receiving a signal comprised of a program signal and an additional signal;
a separating means for separating the program signal and the additional signal from said received signal;
a determining means for determining whether to output in accordance with said additional signal;
an output signal generating means for generating an output signal by using said separated program signal and additional signal upon determination to output in accordance with said additional signal and for generating the output signal by using said separated program signal where it is determined not to output in accordance with said additional signal; and
an outputting means for outputting information in accordance with said generated output signal;
wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal; and
wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service.

2. (Previously Presented) The communication apparatus as set forth in claim 1, further comprising a transmitting means for transmitting log information indicating a log of

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decisions whether to output in accordance with said additional signal to a transmitting side of said received signal.

3. (Previously Presented) The communication apparatus as set forth in claim 1, wherein said receiving means receives a signal comprised of a program signal and an advertisement signal.

4. (Previously Presented) A communication system comprising:
a first communication apparatus for transmitting a signal comprised of a program signal and an additional signal; and
a second communication apparatus for receiving a signal transmitted by said first communication apparatus, said second communication apparatus comprising:
a receiving means for receiving the signal transmitted by said first communication apparatus;
a separating means for separating the program signal and the additional signal from said received signal;
a determining means for deciding whether to output in accordance with said additional signal;
an output signal generating means for generating an output signal by using said separated program signal and said additional signal when it is decided to output in accordance with said additional signal and generating an output signal by using said separated program signal where it is decided not to output in accordance with said additional signal; and
an outputting means for outputting information in accordance with said generated output signal;

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wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal; and

wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service.

5. (Previously Presented) The communication system as set forth in claim 4, wherein said second communication apparatus includes a transmitting means for transmitting log information indicating a log of decisions of whether to output in accordance with said additional signal to the transmitting side of said received signal; and wherein said first communication apparatus charges the user of said first communication apparatus based on said log information received from said second communication apparatus.

6. (Previously Presented) The communication system as set forth in claim 5, wherein said first communication apparatus:
transmits a signal comprised of a program signal and an advertisement signal; and
performs processing for reducing a fee charged to the user of said second communication apparatus for transmission of said program signal when said advertisement signal was output in said second communication apparatus based on said log information received from said second communication apparatus.

7. (Original) A communication system as set forth in claim 5, wherein said first communication apparatus performs processing for reducing the fee charged to the user of said second communication apparatus for transmission of said program signal when said additional

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signal was output in said second communication apparatus based on said log information received from said second communication apparatus.

8. (Original) A communication system as set forth in claim 4, wherein said first communication apparatus charges the user of said second communication apparatus according to a condition determined in advance.

9. (Previously Presented) A communication system as set forth in claim 4, wherein said first communication apparatus transmits a signal comprised of a program signal and an advertisement signal.

10. (Previously Presented) A communication apparatus comprising:
an operating means operated by a user;
a transmitting means for issuing a request instructing the transmission of an additional signal in accordance with operation of said operating means by said user;
a receiving means for receiving a signal comprised of a program signal and an additional signal in accordance with said request;
a separating means for separating the program signal and the additional signal from said received signal;
an output signal generating means for generating an output signal by using said separated program signal and additional signal; and
an outputting means for output information in accordance with said generated output signal;

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wherein the additional signal is displayed simultaneously with the program signal inside or outside a window of a program corresponding to the program signal; and

wherein a viewing fee is reduced by a predetermined amount when the displayed additional signal is an advertisement and the viewing fee is increased by a predetermined amount when the displayed additional signal is an additional service.

11. (Previously Presented) A communication method of a reception side of a signal comprised of a program signal and an additional signal, comprising the steps of:

separating a program signal and an additional signal from said received signal;

determining whether to output in accordance with said additional signal ;

generating an output signal by using said separated program signal and additional signal where it is decided to output in accordance with said additional signal;

generating an output signal by using said separated program signal when it is decided not to output in accordance with said additional signal;

outputting information in accordance with said generated output signal;

displaying the additional signal simultaneously with the program signal inside or outside a window of a program corresponding to the program signal;

reducing a viewing fee by a predetermined amount when the displayed additional signal is an advertisement; and

increasing the viewing fee by a predetermined amount when the displayed additional signal is an additional service.

12. (Previously Presented) The communication method as set forth in claim 11, further comprising the steps of:

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transmitting log information indicating a log of decision of whether to output in accordance with said additional signal from said reception side to the transmission side; and charging said reception side user based on said log information on said transmission side.

13. (Previously Presented) The communication method as set forth in claim 12, further comprising the steps of:

transmitting a signal comprised of a program signal and advertisement signal therein from said transmission side to said reception side; and

having said transmission side perform processing for reducing a fee charged to said reception side user for transmission of said program signal where said advertisement signal is output on said reception side based on said log information received from said reception side.

14. (Original) A communication method as set forth in claim 12, further comprising a step of processing for increasing the fee charged to said reception side user for transmission of said program signal on said transmission side when said additional signal is output on said reception side based on said log information received from said reception side.

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APPENDIX II

EVIDENCE

None

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APPENDIX III

RELATED PROCEEDINGS

None